

REMARKS

Favorable reconsideration of this application is respectfully requested in view of the claim amendments and following remarks.

Status of Claims

Claims 1, 5-9, 15, 19-21, 23-25, 27-29, 31-34, 36-42, 44-49, 51-54, 56, 57, 59-67, 69-75, and 79-83 are currently pending in the application of which claims 1, 15, 20, 47, 62 and 83 are independent.

Claims 2-4, 10-14, 16-18, 22, 26, 30, 35, 43, 50, 55, 58, 68, 71, 76-78 and 84-86 are canceled.

Claims 1, 4-9, 15, 18-21, 23-25, 27-34, 36-54, 56-67, 69-75, and 77-83 were rejected.

Summary of the Office Action

Claims 20-21, 23-25, 27-34, and 36-46 were rejected under 35 U.S.C. §101 for allegedly failing to positively recite an apparatus or machine to perform a method step; and the claimed steps do not result in an article being transformed from one state to another.

Claims 20-21, 23-25, 27-34, and 36-46 were rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 4-9, 15, 18-19, 20-21, 23-25, 27-34, 36-46, 47-54, 56-61, 62-67, 69-75, 77-82, and 83 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,799,286 to Morgan et al. (hereinafter "Morgan") in view of U.S. Patent Application Publication No. 2004/0225549 to Parker et al. (hereinafter "Parker").

The aforementioned rejections are respectfully traversed for at least the reasons set forth below.

Claim Rejection Under 35 U.S.C. §101

Claims 20-21, 23-25, 27-34, and 36-46 were rejected under 35 U.S.C. §101 for allegedly failing to positively recite an apparatus or machine to perform a method step; and the claimed steps do not result in an article being transformed from one state to another. Claim 30 is canceled herein so the rejection of claim 30 is moot.

The rejection states,

Here, applicant's method steps fail the first prong of the new test because the only tie to a computer occurs in only one step, analyzing step, which does not appear to be critical to the claimed invention. The critical steps to the claimed invention appear to be involved with the "modeling" step, "calculating a transition" step and "determining an effect" step and "displaying" step.

Preliminarily, it should be understood that the Examiner agreed in the examiner interview conducted on May 25, 2010, that the recitation of a computer in "analyzing, by a computer, at least one of the business organization data inputs", such as recited in independent claim 20, overcomes the 101 rejection. Accordingly, it is unclear why now this step is being characterized as not being critical.

Secondly, this step of analyzing should not be considered insignificant. The step of analyzing has been amended to recite,

analyzing, by a computer, at least one of the business organization data inputs by comparing the at least one business organization data input to at

least one industry threshold value and performing one or more calculations on the at least one data input and the at least one industry threshold value to determine at least one of a cost analysis, an activity analysis and a sizing analysis for the business organization function.

Thus, analyzing includes performing one or more calculations on at least one data input to determine at least one of a cost analysis, an activity analysis and a sizing analysis for the business organization function. Calculating cannot be considered an insignificant extra-solution activity. Furthermore, there is a transformation of the at least one data input to at least one of a cost analysis, an activity analysis and a sizing analysis for the business organization function, which is performed by the one or more calculations. Thus, there is a transformation of data, and the “computer” is recited with respect to the step describing the transformation. Accordingly, claims 20-21, 23-25, 27-29, 31-34, and 36-46 are tied to a computer, and claims 20-21, 23-25, 27-29, 31-34, and 36-46 describe a transformation.

For at least these reasons, claims 20-21, 23-25, 27-29, 31-34, and 36-46 are statutory and the rejection under 35 U.S.C. §101 should be withdrawn.

Claim Rejection Under 35 U.S.C. §112, 2nd Paragraph

Claims 20-21, 23-25, 27-34, and 36-46 were rejected 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 20-21, 23-25, 27-34, and 36-46 were rejected because independent claim 20 recited “calculate” instead of “calculating”. Claim 20 has been amended to recite “calculating” and thus the rejection is overcome and should be withdrawn.

Claim Rejections Under 35 U.S.C. §103(a)

The test for determining if a claim is rendered obvious by one or more references for purposes of a rejection under 35 U.S.C. § 103 is set forth in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007):

“Under §103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” Quoting *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966).

As set forth in MPEP 2143.03, to ascertain the differences between the prior art and the claims at issue, “[a]ll claim limitations must be considered” because “all words in a claim must be considered in judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385. According to the Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in view of *KSR International Co. v. Teleflex Inc.*, Federal Register, Vol. 72, No. 195, 57526, 57529 (October 10, 2007), once the *Graham* factual inquiries are resolved, there must be a determination of whether the claimed invention would have been obvious to one of ordinary skill in the art based on any one of the following proper rationales:

(A) Combining prior art elements according to known methods to yield predictable results; (B) Simple substitution of one known element for another to obtain predictable results; (C) Use of known technique to improve similar devices (methods, or products) in the same way; (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results; (E) “Obvious to try”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success; (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art; (G) Some teaching, suggestion, or motivation in the

prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007).

Furthermore, as set forth in *KSR International Co. v. Teleflex Inc.*, quoting from *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006), “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasonings with some rational underpinning to support the legal conclusion of obviousness.”

Therefore, if the above-identified criteria and rationales are not met, then the cited reference(s) fails to render the claims obvious and, thus, the claims are distinguishable over the cited reference(s).

- Claims 1, 4-9, 15, 18-19, 20-21, 23-25, 27-34, 36-46, 47-54, 56-61, 62-67, 69-75, 77-82, and 83

Claims 1, 4-9, 15, 18-19, 20-21, 23-25, 27-34, 36-46, 47-54, 56-61, 62-67, 69-75, 77-82, and 83 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over Morgan in view of Parker.

Independent claim 1 recites,

analyze at least one of the business organization data inputs by comparing the at least one business organization data input to at least one industry threshold value and performing one or more calculations on the at least one data input and the at least one industry threshold value to determine at least one of a cost analysis, an activity analysis and a sizing analysis for the business organization function.

The rejection asserts analyzing at least one business organization data input by comparing the at least one input to at least industry threshold value is disclosed by the site comparison described in columns 7 and 19 of Morgan. Column 19, lines 14-20 of Morgan

disclose comparing service costs between different sites. However, Morgan does not disclose comparing the service costs to an industry threshold value. Thus, Morgan does not disclose comparing at least one business organization data input to at least one industry threshold value.

Claim 1 recites, “model multiple business organization transformation opportunity scenarios that include a second state of the first business organization function, different than the first state, responsive to the analysis.” The rejection asserts modeling a business organization transformation opportunity scenario is taught by the forecasting disclosed in columns 7 and 19 of Morgan. However, the forecasting of Morgan is not performed responsive to the comparison of service costs between different sites, which the rejection interprets to be the claimed analysis. Thus, Morgan does not disclose modeling responsive to the claimed analysis.

Furthermore, claim 1 was amended to recite the analysis includes performing one or more calculations on the at least one data input and the at least one industry threshold value to determine at least one of a cost analysis, an activity analysis and a sizing analysis for the business organization function. Morgan does not disclose the forecasting is performed responsive to calculations performed on the data input and the at least one industry threshold value to determine at least one of a cost analysis, an activity analysis and a sizing analysis.

Claim 1 recites,

model multiple business organization transformation opportunity scenarios that include a second state of the first business organization function ...wherein the business organization transformation opportunity scenarios include a broad-outsourcing transformation scenario, an internal transformation scenario and a mix scenario including a mix of outsourcing and internal transformation.

Morgan does not disclose modeling multiple different scenarios that include a broad-outsourcing transformation scenario, an internal transformation scenario and a mix scenario.

Claim 1 also recites,

determine a suggested one of the modeled business organization transformation opportunity scenarios to implement based on the determined effect on the performance matrix for the modeled business organization transformation opportunity scenarios.

Morgan does not determine a suggested scenario to implement based on the determined effect on a performance matrix.

Parker also does not disclose the features of claim 1 described above. The rejection asserts Parker disclose at least one of a broad-outsourcing transformation scenario, an internal transformation scenario and a mix scenario including a mix of outsourcing and internal transformation in paragraphs 32-37, 156-162 and 202-203. Parker discloses applying a value chain analysis to implement large scale outsourcing transactions. See paragraph 33. However, Parker does not disclose the features of claim 1 described above.

Independent claims 15, 20, 47, 62 and 83 recite features similar to claim 1 described above. Accordingly, claims 1, 5-9, 15, 19-21, 23-25, 27-29, 31-34, 36-42, 44-49, 51-54, 56, 57, 59-67, 69-75, and 79-83 are believed to be allowable.

Conclusion

In light of the foregoing, withdrawal of the rejections of record and allowance of this application are earnestly solicited. Should the Examiner believe that a telephone conference with the undersigned would assist in resolving any issues pertaining to the allowability of the above-identified application, please contact the undersigned at the telephone number listed below. Please grant any required extensions of time and charge any fees due in connection with this request to Deposit Account No. 50-3290.

Respectfully submitted,

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